

Serial no. 09/524,076

Amendment in Resp. to Off. Action of Oct. 21, 2003

UTILITY PATENT

B&D No. P-TN-1698

REMARKS

Claims 1 and 4 have been amended. Currently in the above-identified application therefore are Claims 1-11.

The Examiner has rejected Claims 1-6 under 35 USC § 102(a) as anticipated over DE 197 06 408 ("DE '408"). Reconsideration and withdrawal of these rejections are respectfully requested.

Claim 4, as amended, calls for a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, a fence attached to the base assembly for supporting a workpiece and having a fence plane, the table having a table plane, a saw assembly including a motor and a blade driven by the motor, the blade having a radius and a blade center, and a pivot arm pivotally attached to the table and pivotally supporting the saw assembly about a first axis substantially parallel to the table plane, allowing a user to plunge the blade below the table plane, wherein distance between the first axis and the table plane is about 0.472 times the radius, distance between the first axis and the fence plane is about 1.45 times the radius, and distance between the first axis and the blade center is about 1.882 times the radius.

Admittedly, DE '408 shows a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, the table having a table plane, a fence connected to the base assembly and having a fence plane, a saw assembly including a motor and a blade driven by the motor, the blade having a radius and a blade center, and a pivot arm pivotally attached to the

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table and pivotally supporting the saw assembly about a first axis substantially parallel to the table plane, allowing a user to plunge the blade below the table plane. However, based on Figure 3 of DE '408, the distance between the first axis and the table plane is 0.57 times the radius and the distance between the first axis and the fence plane is 0.927 times the radius.

By contradistinction, Claim 4 calls for the "distance between the first axis and the table plane is about 0.472 times the radius, distance between the first axis and the fence plane is about 1.45 times the radius." According to the MPEP, a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, at 2100-70. Because DE '408 does not disclose such dimensions, DE '408 cannot anticipate Claims 4-11.

The Examiner may argue that it would be obvious to modify DE '408 to obtain such specific dimensions. Admittedly, differences in ranges will not support the patentability of the claimed subject matter "unless there is evidence that such [range] is critical." See MPEP § 2144.05(II)(A), at 2100-138. In fact, the "law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims In such a situation, the applicant must show that the particular range is critical generally by showing that the claimed range achieves unexpected results relative to the prior art range." MPEP § 2144.05(III), at 2100-138. Evidence of unexpected results (and thus of nonobviousness) includes evidence of superiority of a property shared with the prior art. MPEP § 716.02(b), at 700-240. Similarly, evidence of a property not possessed by the prior art is evidence of nonobviousness. *Id.*

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In the present case, having an arrangement with the claimed dimensions is critical because a miter saw with such dimensions can cut certain desired workpiece with a smaller blade that were not previously achievable. As evidenced by the previously-submitted declaration of Peter Chaikowsky, a ten-inch miter saw according to the present invention can cut both a 6.5" by $\frac{3}{4}$ " workpiece and a dimensional 4" by 4" workpiece without requiring changing the position of the fence plane. By comparison, DE '408 discloses a ten-inch miter saw that, while it certainly can cut a 6.5" by $\frac{3}{4}$ " workpiece as shown in Figure 5. To cut a 4" by 4" workpiece, however, the user needs to change the position of the fence plane. Such step is not necessary in the ten-inch miter saw according to Claim 4.

The ability to cut the certain desired workpieces described above without moving the position of the fence plane forwardly or rearwardly to accommodate a different-sized workpiece is a property not possessed by DE '408. Furthermore, the ability to cut a dimensional 4" by 6" workpiece with a ten-inch blade is a property superior to the prior art. Under the MPEP, these facts are evidence of nonobviousness over DE '408. Therefore Claims 4-11 are allowable over DE '408.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 1-11 are respectfully requested.

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No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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